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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,458	07/12/2002	Roy G Gordon	42697.127WOI	1413

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EXAMINER

ANTHONY, JOSEPH DAVID

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,458

Applicant(s)

GORDON ET AL.

Examiner

Joseph D. Anthony

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 14-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Election/Restrictions

2. Applicant's election with traverse of Group II, Claim 13, in the reply filed on 05/06/04 is acknowledged. Due to applicant's amendment filed with the election, claims 1-13 will be examined. Claims 14-22 remain withdrawn for the reasons of record. The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 13, and dependent claims 2 and 6-7 are all deemed to be confusing due to the use of the word "amide" to set forth the nature of the ligand component. The problem here is that according to the listed ligand structural formulas, the ligand is not an amide but is rather an --amine--. Dependent claims

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3-5 and 8-12 are being rejected here because they contain all the limitations of the rejected base claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6, 9 and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Derwent Publication Ltd., Accession Number 113:78097, Taken from J. Hetrocyclo. Chem (1989), 26(6), pages 1771-1780 which teaches compositions that contain: **Silamine, 1-(1,1-dimethylethyl)-N-[(1,1-dimethylethyl)dimethylsilyl]-1,1-dimethyl, sodium salt.**

7. Claims 1-6, 8, and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Derwent Publication Ltd., Accession Number 107:96786, Taken from Chima (1986), 40(6), pages 202-205 which teaches compositions that contain: **Silamine, 1-(1,1-dimethylethyl)-N-[(1,1-dimethylethyl)dimethylsilyl]-1,1-dimethyl, lithium salt.**

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 7 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Derwent Publication Ltd., Accession Number 113:78097, Taken from J. Hetrocyclo. Chem (1989), 26(6), pages 1771-1780 or Derwent Publication Ltd., Accession Number 107:96786, Taken from Chima (1986), 40(6), pages 202-205.

Both Derwent Publications have been described above. They differ from applicant's claimed invention in the following ways: 1) there is no direct disclosure to making or using silanamines that correspond to applicant's structure of claim 7., 2) there is no direct disclosure to the use of potassium in leu of sodium or lithium, and 3) there is no direct disclosure to silanamine type alkali metal salts that correspond to applicant's claimed silanamine alkali metal salts where applicant's subscript "n" is in the range of 2 to 3.

It would have been obvious to one having ordinary skill in the art to use the individual disclosure of either Derwent Publication as motivation to actually make compositions that contain silamines that correspond to applicant's claimed silanamines. This is obvious because both Derwent Publications are deemed to broadly disclosure the production and use of silanamines that encompass

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applicant's claimed silanamines. Furthermore, it is deemed to be obvious to substitute potassium in leu of sodium or lithium since all three are alkali metals and are deemed to be functional equivalent of each other.

Prior-Art Cited But Not Applied

10. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

Examiner Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. This examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 6:30 p.m. in the eastern time zone. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (703) 872-9306. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.



**Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714**

6/14/04